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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,684	11/15/2001	Hisashi Kashima	JP9-2000-0253	2580
30743	7590	11/17/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			SUBRAMANIAN, NARAYANSWAMY	
		ART UNIT	PAPER NUMBER	
			3624	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/003,684	KASHIMA ET AL.	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6, 13-18, 25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6, 13-18, 25 and 27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This office action is in response to applicants' communication filed on October 26, 2005. Amendments to the specification and claims 1, 3, 5, 13, 15, 17, 25 and 27 and cancellation of claims 7-12, 19-24 and 26 have been entered. Rejections made under 35 USC § 101 in the last office action mailed on are withdrawn in view of the amendments. Rejection of claims 1, 2, 7-14, 18, 25 and 27 made under 35 USC § 112, second paragraph are withdrawn in view of the amendments. Claims 1-6, 13-18, 25 and 27 are pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6, 13-18, 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Appropriate clarification/correction is required.

Independent claims 1, 13, 25 and 27 recite in the preamble a method, or system or a computer-readable storage medium for holding an auction for a product". However the first limitation in all these claims recite "receiving bids for each product type of multiple product types in a transaction". It is not clear how the limitations are related to the preamble which calls for auction for a product, when the steps in the claim recite steps of auction for multiple products. Hence the metes and bounds of these limitations

are not clear. Claims 2-6 and 14-18 are rejected by dependency. Appropriate clarification/correction is required.

In claims 3, 5, 15 and 17, the variable "k" is recited to have a value between "0" and "n". Paragraph 10 on page 3 of the specification discloses "k" can have a value between "0" and "n+1". It is not clear which of the two constraints for "k" is correct. Appropriate clarification/correction is required.

Independent claim 13 recites "means for receiving bids from at least one computer or from multiple computers within a network of computers" and "bids that were received from at least one computer or from multiple computers within said network of computers". It is not clear if receiving bids from at least one computer or from multiple computers are the same computer or computer from which bids were received. Claims 14-18 are rejected by dependency. Appropriate clarification/correction is required.

In claim 25, the limitation "using said that were received while using said process for receiving bids" is not clear. Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietrich (US Patent 2003/0018560 A1) as discussed in paragraphs and 6 of the last office action mailed on August 1, 2005

Response to Arguments

6. In response to applicant's argument on page 16 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the subject invention enables a bidder to specify a variety of items across a range of quantities for each bid") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments, that the claimed subject invention is trying to maximize the profit for the vendor products, is not clear. The independent claims use evaluation prices obtained from the bidders and the desired range of quantities in conjunction with dynamic programming to determine an optimum set of bids within the constraints of product availability. The objective function (especially in the dependent claims) is specified such that revenue is maximized. Unless costs are considered in the objective function, the profit cannot be maximized. But there is no mention of costs anywhere in the claims. The example provided by the applicants on page 16 of the amendment illustrate the examiners arguments further about the difference between revenue maximization and profit maximization. Hence it is not clear to one of ordinary skill in the

arts as to how the profits are maximized in the way the invention is claimed. Clarification is required.

In response to applicant's arguments on page 17 that the independent claims "include the requirement that bids are received for each product type of multiple product types in a transaction", it is not clear how this requirement further limits the claim when the preamble calls for steps of holding an auction for a product. Further the teaching of Dietrich restricting each bid to only one product type is irrelevant because nowhere is it claimed that each bid must include bids on multiple product types. The preamble calls for steps of holding an auction for a product. By applicant's own admission on page 17, the applied art teaches the invention when there is only one product. Hence all the limitations of the claims are taught by the applied art.

The arguments and illustration presented by the applicants asserting that combination of products are considered in determining the optimum bid is relevant only to the claims that were restricted and cancelled by the applicants. There is no limitation in the claimed invention that recites evaluation of products in combination.

Applicant's other arguments with respect to pending claims have been considered but are not persuasive.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Dr. N. Subramanian
November 14, 2005



JAGDISH N. PATEL
PRIMARY EXAMINER